

REMARKS

THE AMENDMENTS AND REASONS FOR AMENDMENTS

Applicant amends claims 150, 157, 159, 176, 178, 181 and 189, cancels claims 156, 158, 160, 177, 186 through 188, and 190, and adds new claim 206. The new claim adds no new subject matter and is fully supported by the application, including the specification, figures, and claims as originally filed.

The amendments are made to clarify the claimed invention and to expedite the allowance of the present application. Applicant reserves the right to file applications claiming the benefit of priority to the present application claiming the subject matter of the present and other applications.

CLAIM OBJECTIONS AND ALLOWABLE SUBJECT MATTER

The Examiner objected to claims 175, 178, and 181 because of certain informalities, namely that the “c” after “The” should be removed in claim 175, that the word “transfected” should be spelled correctly in claim 178, and that the word “enhancer” should be spelled correctly in claim 181.

The Examiner objected to claims 160 and 190 as being dependent upon a rejected base claim, but the Examiner states that claims 160 and 190 would be allowable if rewritten in independent form.

Applicant has amended claims 175, 178, and 181 to correct certain informalities as requested by the Examiner. Applicant has also amended independent claim 150 to incorporate the feature of allowable claim 160 and has amended independent claim 176 to incorporate the feature of allowable claim 190. Thus Applicant respectfully submits that all of the pending claims are allowable.

NEW GROUNDS OF REJECTION

THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner rejected claims 161-163 under 35 U.S.C. § 112, second paragraph, as allegedly lacking antecedent basis for “said nucleic acid molecule encoding CYP3A.” The Examiner alleges that “the nucleic acid in claim 176 [*sic*] from which each of these claims depends” provides for “a promoter or enhancer operable for a nucleic acid molecule encoding CYP3A, and a reporter gene.” This, the Examiner alleges, does not provide sufficient antecedent basis for “said nucleic acid molecule encoding CYP3A.”

The Examiner rejected claims 191-193 under 35 U.S.C. § 112, second paragraph, as allegedly being vague and indefinite due to the lack of clarity of the phrase “[produces transcriptional activation of a gene encoding CYP3A.”

Applicant respectfully disagrees with the Examiner with respect to the rejection of claim 161-163 and 191-193, however, in order to expedite allowance of the claims, Applicant has amended independent claims 150 from which claims 161-163 depend from, and independent claim 176 from which claim 191-193 depend from in order to include “a nucleic acid encoding CYP3A.”

THE PRIOR ART FAILS TO ANTICIPATE THE CLAIMED INVENTION UNDER 35 U.S.C. 102

The Examiner rejected claims 150-158, 161-164, 167-172, 176, 177, 181-188, 191-194, and 197-202 under 35 U.S.C. § 102(a) as allegedly being anticipated by Liddle et al. (WO 99/61622). To expedite allowance of claims, Applicant has amended independent claims 150 to include the allowable feature of claim 160, and has amended independent claim 176 to include the allowable feature of claim 190 rendering this rejection moot. Thus, Liddle et al. does not anticipate the claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected claims 176, 181, 184, 186, 191-201, and 205 under 35 U.S.C. § 102(b) as allegedly being anticipated by Lehmann et al. (*Journal of Clinical Investigation*, 1998). To expedite allowance of claims, Applicant has amended independent claims 176 to include the allowable feature of claim 190 rendering this rejection moot. Thus, Lehmann et al. does not anticipate the claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

APPLICANT'S CLAIMED INVENTION IS NOT OBVIOUS UNDER 35 U.S.C. § 103(A) IN VIEW OF THE REFERENCES CITED BY THE EXAMINER

The Examiner rejected claims 150, 165, 176, 178, 179, and 195 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Liddle et al. (WO 99/61622). To expedite allowance of claims, Applicant has amended independent claims 150 to include the allowable feature of claim 160, and has amended independent claim 176 to include the allowable feature of claim 190 rendering this rejection moot. Thus, Liddle et al. does not anticipate the claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected claims 150, 173-176, and 203-205 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Liddle et al. (WO 99/61622), in view of Windmill et al. (*Mutation Research*, 1997). To expedite allowance of claims, Applicant has amended independent claims 150 to include the allowable feature of claim 160, and has amended independent claim 176 to include the allowable feature of claim 190 rendering this rejection moot. Thus, Liddle et al. does not anticipate the claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected claims 176, 180, 182, 184, 186, 194, 197-199, and 205 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Liddle et al. (WO 99/61622), in view of Collins et al. (US Patent 6,579,686). To expedite allowance of claims, Applicant has amended independent claims 176 to include the allowable feature of claim 190 rendering this rejection moot. Thus, Lehmann et al. does not anticipate the claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected claims 150, 159, 165, 166, 176, 189, 195, and 196 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Liddle et al. (WO 99/61622), in view of Lehmann et al. (*Journal of Clinical Investigation*, 1998) and Pascussi et al. (*Molecular Pharmacology*, 2000). To expedite allowance of claims, Applicant has amended independent claims 150 to include the allowable feature of claim 160, and has amended independent claim 176 to include the allowable feature of claim 190 rendering this rejection moot. Thus, Liddle et al. does not anticipate the claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Applicant respectfully submit that the claims are ready for examination and in condition for allowance. Please apply any charges not covered, or any credits, to **Deposit Account Number 501321** in the name of David R. Preston & Associates, having **Customer Number 24232**.

Respectfully submitted,

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